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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,739	03/23/2004	Harry N. Mason	G595A	2560

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EXAMINER

MITCHELL, KATHERINE W

ART UNIT PAPER NUMBER

3677

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/806,739

**Applicant(s)**

MASON, HARRY

**Examiner**

Katherine W Mitchell

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Oath/Declaration***

1. The oath or declaration is defective. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.

Examiner notes that applicant has listed the city and state twice, and thus examiner will accept that the city and state listed before the post office address section both refer to applicant's residence. If this is correct, no action is required; otherwise, a new declaration is required.

### ***Information Disclosure Statement***

2. Per MPEP section 609, the examiner will consider information which has been considered by the Office in a parent application when examining a continuation application filed under 37 CFR 1.53(b) or filed under former 37 CFR 1.60. A listing of the information need not be resubmitted in the continuing application unless the applicant desires the information to be printed on the patent.

### ***Claim Objections***

3. Claims 5 and 6 are objected to because of the following informalities: Applicant claims "an interchangeable charm earring method" in claims 5 and 6. A preamble of a method claim must describe a method, and "an interchangeable charm earring" is an apparatus. Examiner suggests --A method of using an interchangeable charm earring...--.

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Line 9 of claim 5 recites...for use with at least one charm...". Applicant claims the method "using an earring"; thus it should also be --using-- a charm. To be a consistent method claim, the method is for use with a pierced ear (not positively recited) and the method includes using an interchangeable charm earring and using at least one charm (both consistently positively recited). Appropriate correction is required.

Claim 5 discloses "a pierced ear having a pierced hole". The hole pierces the ear, but the hole itself is not pierced. It would be more correct to claim --a pierced ear having a hole therethrough--.

### ***Claim Objections***

4. Claims 1-6 are objected to because of the following informalities: Claim 1 discloses that the earring has a body having "a substantially uniform cross section through its length", and then further discloses that the same body has a blocked end". Thus the end is part of the body, and this part of the body specifically contradicts the uniform cross section. This can be corrected by specifying --a substantially uniform cross section through its length except at one end--. Claims 2-6 are objected to as depending from claim 1. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

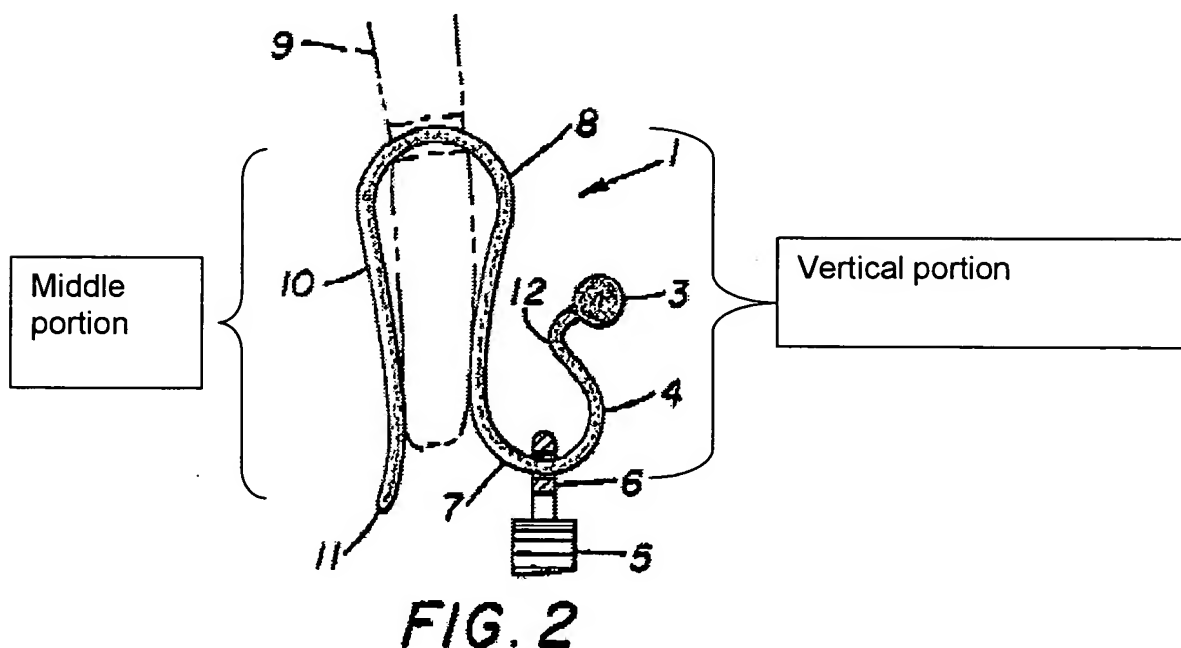
5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chicckine USP 4221118 in view of Mason USP 4497186.

Re claim 1: Chicckine shows in Fig 2 a secure interchangeable earring for use with a pierced ear, the earring having a charm with a charm opening, and further comprising a body formed from a single integral piece of substantially uniform cross section, the body comprising a free end (11) for threading through the pierced ear (9) and sized to extend through the charm opening (6) (col 1 line 62 - col 2 line 3), a blocked end (3) to prevent dislodgement of the charm from the earring thereat; an apex portion (that portion in the ear hole), a vertical portion between the apex and the blocked end, and another middle portion (16) between the apex and the free end.



Chicckine further teaches a charm (5) with a charm opening (6 - seen in cross section in the figures), and shows the body (1) sized to allow the charm to move fully from the free end to the blocked end, such that when the earring body is threaded onto the ear with

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the apex at the pierced hole, the charm is trapped between the blocked end and the pierced hole (shown in both figures). However, Chicckine lacks that the middle portion between the free end and the apex is spiraling. Mason teaches an earring with an apex and a spiraling section for additional decoration in the figures, especially Figs 2 and 8:

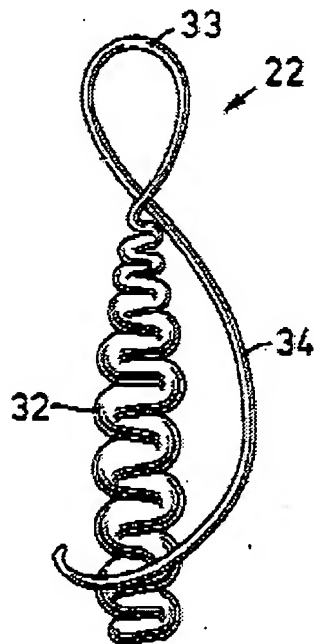


FIG. 8

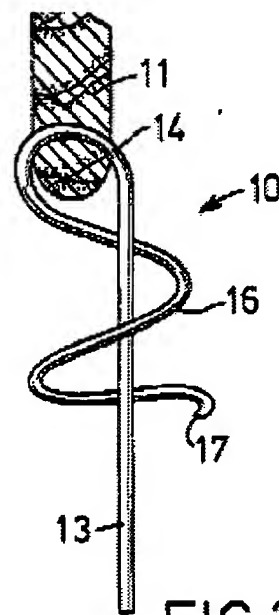


FIG. 2

Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Chicckine and Mason before him at the time the invention was made, to modify Chicckine as taught by Mason to include the decorative spiral of Mason, in order to obtain a more decorative and versatile earring, as Mason teaches in col 1 lines 60-63 that it is an advantage to have part of the attachment portion also serve as a decorative feature, (referring to the spiral).

Re claim 2: Chicckine teaches the earring further comprises a ball (3 in Fig 2) at the blocked end with a diameter larger than the earring charm (5) in the Figures and in col 1 lines 56-61.

Re claim 4: Chicckine teaches a curved bottom portion having a valley (7) and high point (12), the blocked end (3) located at the high point wherein the charm rests in the bottom portion of the valley when in place on the earring (Fig 3).

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Re claims 5-6: As discussed above, the earring is obvious over Chicckine in view of Mason. The method of use is intrinsically taught by the apparatus, as no other method would result in the arrangement in Fig 2, and the method is further discussed by Chicckine in col 1 lines 64-col 2 line 3. Charm installation would be as shown in Fig 2.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chicckine in view of Mason as applied above and further in view of Sustain, DES. 175867.

Re claim 3: Chicckine in view of Mason discloses the claimed invention except for the plurality of concentric circles at the blocked end which do not allow the charm to pass that portion of the body. As for decorative effect, Chicckine specifically teaches in col 1 lines 59-61 that the shape of the enlarged head can vary as long as it is aesthetically pleasing.

Sustain discloses an earring with a decorative end comprising the wire body bent to form concentric circles which would not allow a charm to pass (Fig 3). Therefore, it would have been an obvious matter of design choice to one of ordinary skill in the art at the time the invention was made, to change the design of the blocked end, since applicant has not disclosed that concentric circles versus a ball end

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solves any stated problem or is for any particular purpose and it appears that the invention would equally well with the ball end.

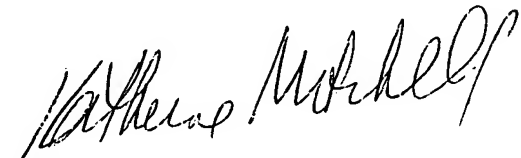
**Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W Mitchell whose telephone number is 703-305-6713. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Katherine W Mitchell  
Patent Examiner  
Art Unit 3677

Kwm  
9/2/04